

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

Rejection of Claims 1 and 2 Under 35 U.S.C. §102(b)

The Examiner has rejected Claims 1 and 2 under 35 U.S.C. §102(b) as being inherently anticipated by Hastings *et al.* (U.S. 5,626,849). The Examiner asserts that Hastings *et al.* teach the use of (-) citric acid for the purpose of weight loss, and that there “has to be some type of inflammation in the body at any given moment.” (Page 2 of the Office Action).

Applicants respectfully disagree.

A reference is said to inherently anticipate a claim if the cited reference necessarily and inevitably produces the claimed result upon performance of the method steps (*Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003)). The Examiner Claims that Hastings *et al.* teaches the method steps of Claims 1 and 2, and, since there “has to be some type of inflammation” in a subject, the reference, therefore produces the result of treating or ameliorating inflammation. Applicant points out that there is no teaching to support the notion that every subject must be suffering from inflammation, let alone a teaching that the inflammation is such that it can be ameliorated.

The Examiner does not provide any evidence to support the claim that every possible subject has to experience some type of inflammation that can be treated or ameliorated. Indeed, if the Examiner’s assertion is that inflammation is always present, then inflammation can not be eliminated by any method, otherwise there would exist a state of the subject that is free from inflammation. Regardless, the Examiner has not cited any support for the simple assertion that any of the subjects taught by Hastings *et al.* experienced inflammation at the time of administration. Therefore, the Examiner has not demonstrated that the effect of ameliorating inflammation necessarily and inevitably occurred in the subjects taught by Hastings *et al.* As the “inevitable and necessary” standard has not been met, Hastings *et al.* cannot inherently anticipate Applicant’s claimed invention.

Additionally, Applicant's claimed invention is directed to an "effective amount" of (-)-hydroxycitric acid to be administered to a subject to ameliorate inflammation. The term is tautologically dependent on the amount being effective for ameliorating inflammation. As Hastings *et al.* allegedly describe using citric acid for weight loss, one of skill in the art would not have been compelled to determine an effective amount useful for treating inflammation. Although determining an effective amount is a determination one of skill in the art can make, such a determination is dependent upon the desired effect. An effective amount for weight loss is not necessarily an effective amount for ameliorating inflammation. Therefore, the teachings of Hastings *et al.* would not inevitably and necessarily have led to the claimed result upon administration, namely, amelioration of inflammation.

In view of the above remarks, Applicant asserts that there is nothing in the teachings of Hastings *et al.* that directly anticipates the claimed invention, as Hastings *et al.* do not teach treating inflammation, and, furthermore, there is nothing in the teachings of Hastings *et al.* that inherently anticipates Applicant's claimed invention as Hastings *et al.* do not teach administration to a subject suffering from treatable inflammation nor do they teach administration of an amount effective for treating inflammation. In light of these remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection of Claims 4-6 Under 35 U.S.C. §102(e)

The Examiner has rejected Claims 4-6 under 35 U.S.C. §102(e) as being inherently anticipated by Clouatre *et al.* (U.S. 6,447,807). The Examiner asserts that Clouatre *et al.* teach the use of (-)-hydroxycitric acid in a sustained release form for the purpose of weight loss and appetite suppression. The Examiner again asserts that there "has to be some type of inflammation in the body at any given moment." (Page 2 of the Office Action).

Applicants respectfully disagree.

A reference is said to inherently anticipate a claim if the cited reference necessarily and inevitably produces the claimed result upon performance of the method steps (*Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379 (Fed. Cir. 2003)). The Examiner Claims that Clouatre *et al.* teach the method steps of Claims 4-6, and, since there "has to be some type of

inflammation” in a subject, the reference, therefore produces the result of treating or ameliorating inflammation.

For the reasons set forth above, the Examiner has not established by any credible means that every possible subject has to experience some type of inflammation that can be treated or ameliorated. Therefore, the Examiner has not demonstrated that the effect of ameliorating inflammation necessarily and inevitably occurred in the subjects taught by Clouatre *et al.* As the “inevitable and necessary” standard has not been met, Clouatre *et al.* cannot inherently anticipate Applicant’s claimed invention.

Additionally, Applicant’s claimed invention is directed to an “effective amount” of (-)-hydroxycitric acid to be administered to a subject to ameliorate inflammation. As set forth above, absence a teaching that one of skill in the art would have determined an effective amount suitable for ameliorating inflammation, the teachings of the Clouatre *et al.* reference would not inevitably and necessarily produce an amelioration of inflammation upon administration of (-)-hydroxycitric acid. An effective amount for weight loss is not necessarily an effective amount for ameliorating inflammation. Therefore, the teachings of Clouatre *et al.* would not inevitably and necessarily have led to the claimed result upon administration, namely, amelioration of inflammation.

In view of the above remarks, Applicant asserts that there is nothing in the teachings of Clouatre *et al.* that directly anticipates the claimed invention, as Clouatre *et al.* do not teach treating inflammation, and, furthermore, there is nothing in the teachings of Clouatre *et al.* that inherently anticipates Applicant’s claimed invention as Clouatre *et al.* do not teach administration to a subject suffering from treatable inflammation nor do they teach administration of an amount effective for treating inflammation. In light of these remarks, reconsideration and withdrawal of the rejection are respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to

Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extension fee to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

FOLEY & LARDNER LLP
Customer Number: 48329
Telephone: (617) 342-4077
Facsimile: (617) 342-4001

Michael M. Yamauchi, Ph. D.
Attorney for Applicant
Registration No. 58,468